

REMARKS/ARGUMENTS

Claims 1-9 and 11-17 are present in this application. By this Amendment, claim 1 has been amended. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Entry of this Amendment is proper under 37 C.F.R. §1.116 since the Amendment: (a) places the application in condition for allowance (for the reasons discussed herein); (b) does not raise any new issue requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution and raised by the Examiner in the previous Office Action); (c) satisfies a requirement of form asserted in the Office Action; (d) does not present any additional claims without canceling a corresponding number of finally-rejected claims; and (e) places the application in better form for appeal, should an appeal be necessary. The Amendment is necessary and was not earlier presented because it is made in response to arguments raised in the Final Rejection. Entry of the Amendment is thus respectfully requested.

Claims 1, 6-9, 11, 14 and 15 were rejected under 35 U.S.C. §101. Without conceding this rejection, claim 1 has been amended to recite that the transferor accesses the depository administrator via a global network using a computer, and the transferor requesting a transfer or hold of funds in the transferor deposit sub-account using the computer via the global network to or for the benefit of the transferee. Applicant submits that the claims now more clearly satisfy the requirements of 35 U.S.C. §101 and the Federal Circuit's decision in *In re Bilski* as interpreted by the Patent Office. Withdrawal of the rejection is requested.

Claims 1-9 and 11-17 were rejected under 35 U.S.C. §103(a) over U.S. Published Patent Application No. 2002/0026396 to Dent in view of U.S. Published Patent Application No. 2001/0034676 to Vasic. This rejection is respectfully traversed.

Applicant respectfully reasserts the arguments from the response filed January 5, 2009. In the “Response to Arguments” section in the present Office Action, the Examiner contends that “the claim language does not positively recite transferring step, but instead recites a limitation characterizing the sub-account.” To the contrary, however, step (d) in claim 1 specifically recites that the depository administrator processes the funds between the transferor deposit sub-account and the transferee deposit sub-account. Since the Vasic publication does not disclose any capability of processing funds between different sub-accounts, Applicant submits that the conclusions in the Office Action are misplaced and the rejection should be withdrawn. The mere capability of transferring funds between sub-accounts in the Vasic patent is not sufficient to support the conclusion of obviousness. See, e.g., *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)(“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”). See also, *Ex parte Levengood*, 28 USPQ2d 1300, 1301–02 (B.P.A.I. 1993) (“That which is within the capabilities of one skilled in the art is not synonymous with obviousness. . . .”).

In paragraph 8, the Office Action notes that “Dent teaches the transfer of funds between accounts.” In contrast with the claimed invention, however, the financial service center 102 in Dent requires that the transaction participants provide access to independent accounts. See, for example, paragraph [0014], [0046], [0050], [0094], [0123] and others. Since the Vasic publication does not even remotely suggest an ability or desire to transfer funds between sub-accounts, Applicant submits that those of ordinary skill in the art would not look to Vasic to improve the system disclosed in Dent. Even under the Supreme Court’s *KSR* decision, the combination of Dent and Vasic would not yield predictable results since the combined teachings

do not perform the same functions as they do separately. That is, since the Vasic system neither discloses nor suggests an ability to transfer funds between sub-accounts, incorporating Vasic into the Dent system would require the Vasic system to perform in a way that it does not perform separately. As such, Applicant submits that the rejection is misplaced.

With regard to dependent claims 2-9 and 11-15, Applicant submits that these claims are allowable at least by virtue of their dependency on an allowable independent claim. Moreover, with regard to claim 6, the Examiner contends that “Applicant has provided the Examiner with neither reasoning nor evidence in support of the argument that the authorization feature taught by Dent in par 123 does not fairly suggest the holding features recited in claim 6.” In this context, the definition found by the Examiner of the term “hold” is inconsistent with the use of the term in the present specification. As described in the specification, funds that are held in a transferor’s deposit sub-account are made unavailable to the transferor, giving the transferee assurance that the funds will be transferred upon the occurrence of a predefined condition. See, for example, page 9, lines 16-28. In the Dent publication, prior to selecting the authorization button, the funds remain available to the account holder. As such, by Applicant’s specific definition of held funds, the funds in the Dent publication do not suggest the feature of claim 6. As noted in the previously-filed response, this distinction would be readily apparent to those of ordinary skill in the art. Claims 7-9 further define this feature. As also noted previously, these additional definitions are similarly distinguishable from merely selecting an authorization button.

Applicant further submits that independent claims 16 and 17 are allowable for reasons discussed in the previous response and for reasons similar to those discussed above with regard to claim 1.

Reconsideration and withdrawal of the rejection are respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully submits that the claims are patentable over the art of record and that the application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Prompt passage to issuance is earnestly solicited.

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to Deposit Account No. 14-1140.

Respectfully submitted,

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